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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,963	10/12/2001	Michael T. Caplan	2002834-0115	2907

24280 7590 03/03/2003

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EXAMINER

WEDDINGTON, KEVIN E

ART UNIT PAPER NUMBER

1614

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/976,963

Applicant(s)
Caplan et al.

Examiner
Kevin E. Weddington

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1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Nov 6, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above, claim(s) 11-28 and 42-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 29-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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CLAIMS 1-56 ARE PRESENTED FOR EXAMINATION.

APPLICANTS' ELECTION FILED NOVEMBER 6, 2002 IN RESPONSE TO THE RESTRICTION REQUIREMENT OF OCTOBER 4, 2002 HAS BEEN RECEIVED AND ENTERED. THE APPLICANTS ELECTED THE SPECIES DESIGNATED AS "L", PERMITS RELEASE OF MIS-ASSEMBLED OR MIS-FOLDED PROTEINS FROM THE ENDOPLASMIC RETICULUM.

CLAIMS 11-28 AND 42-52 ARE WITHDRAWN FROM CONSIDERATION AS BEING DRAWN TO THE NON-ELECTED INVENTION (37 CFR 1.142(B)).

DOUBLE PATENTING

CLAIMS 1-10 AND 29-41 ARE REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIM 1 OF U.S. PATENT NO. 6,344,475. ALTHOUGH THE CONFLICTING CLAIMS ARE NOT IDENTICAL, THEY ARE NOT PATENTABLY DISTINCT FROM EACH OTHER BECAUSE THE PRESENT APPLICATION TEACHES A METHOD OF TREATING RHINOSINUSITIS OR ALLEVIATING THE SYMPTOMS BY ADMINISTERING AN AGENT THAT PERMITS THE RELEASE OF PROTEIN FROM THE ENDOPLASMIC RETICULUM, AND THE PATENTED APPLICATION TEACHES A METHOD OF TREATING ANY DISEASE OR CLINICAL CONDITION WITH THE SAME AGENT. CLEARLY, THE PRESENT APPLICATION METHOD (RHINOSINUSITIS) IS TAUGHT BY THE PATENTED APPLICATION'S BROAD METHOD OF TREATING ANY DISEASE OR CLINICAL CONDITION, IN WHICH, THE PRESENT APPLICATION'S DISEASE OR CLINICAL CONDITIONS FALLS WITHIN.

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THE NONSTATUTORY DOUBLE PATENTING REJECTION IS BASED ON A JUDICIALLY CREATED DOCTRINE GROUNDED IN PUBLIC POLICY (A POLICY REFLECTED IN THE STATUTE) SO AS TO PREVENT THE UNJUSTIFIED OR IMPROPER TIMEWISE EXTENSION OF THE "RIGHT TO EXCLUDE" GRANTED BY A PATENT AND TO PREVENT POSSIBLE HARASSMENT BY MULTIPLE ASSIGNEES. SEE *IN RE GOODMAN*, 11 F.3D 1046, 29 USPQ2D 2010 (Fed. Cir. 1993); *IN RE LONGI*, 759 F.2D 887, 225 USPQ 645 (Fed. Cir. 1985); *IN RE VAN ORNUM*, 686 F.2D 937, 214 USPQ 761 (CCPA 1982); *IN RE VOGEL*, 422 F.2D 438, 164 USPQ 619 (CCPA 1970); AND, *IN RE THORINGTON*, 418 F.2D 528, 163 USPQ 644 (CCPA 1969).

A TIMELY FILED TERMINAL DISCLAIMER IN COMPLIANCE WITH 37 CFR 1.321© MAY BE USED TO OVERCOME AN ACTUAL OR PROVISIONAL REJECTION BASED ON A NONSTATUTORY DOUBLE PATENTING GROUND PROVIDED THE CONFLICTING APPLICATION OR PATENT IS SHOWN TO BE COMMONLY OWNED WITH THIS APPLICATION. SEE 37 CFR 1.130(b).

EFFECTIVE JANUARY 1, 1994, A REGISTERED ATTORNEY OR AGENT OF RECORD MAY SIGN A TERMINAL DISCLAIMER. A TERMINAL DISCLAIMER SIGNED BY THE ASSIGNEE MUST FULLY COMPLY WITH 37 CFR 3.73(b).

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CLAIM REJECTIONS - 35 U.S.C. § 112

CLAIMS 29-41 ARE REJECTED UNDER 35 U.S.C. 112, SECOND PARAGRAPH, AS BEING INDEFINITE FOR FAILING TO PARTICULARLY POINT OUT AND DISTINCTLY CLAIM THE SUBJECT MATTER WHICH APPLICANT REGARDS AS THE INVENTION.

CLAIMS 29-41 ARE RENDERED INDEFINITE BECAUSE THE CLAIMS DEPEND UPON NON-ELECTED CLAIMS 12, 17 AND 24.

CLAIMS 1-10 AND 29-41 ARE NOT ALLOWED.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO EXAMINER K. WEDDINGTON WHOSE TELEPHONE NUMBER IS (703) 308-1235.


Kevin E. Weddington
Primary Examiner
Art Unit 1614

K WEDDINGTON

FEBRUARY 27, 2003